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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/706,849
Filing Date: November 07, 2000
Appellant(s): FISHER ET AL.

Mark D. Yuan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 1, 2010 appealing from the Office action mailed March 1, 2010.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,845,265	Woolston	12-1998
5,047,959	Philips et al	09-1991
5,329,589	Fraser et al.	07-1994

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5,826,244	Huberman	08-1998
5,794,219	Brown	08-1998
Mackinnon, D. J., "Playing the Auction Game"; SU2 Edition, Toronto Stare, Ontario.		10-1987

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-22, 24-30, 32-39, 41-48 and 50-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the limitation "a bid validation... for ensuring that the bid amount is credible in view of a current high bid". There is no support for this limitation in the originally filed disclosure. Applicant is requested to cite portion(s) of the originally filed disclosure that provides support for this limitation.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-22, 24-25, 44-48 and 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Per Claims 18-22 and 24-25, Applicant asserts that the claim elements “means for” are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, it is unclear whether the claim elements are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. If applicant wishes to have the claim limitations treated under 35 U.S.C. 112, sixth paragraph, applicant is required to:

(a) Amend the claim to include the phrase “means for” or “step for” in accordance with these guidelines: the phrase “means for” or “step for” must be modified by functional language and the phrase must **not** be modified by sufficient structure, material, or acts for performing the claimed function; or

(b) Show that the claim limitation is written as a function to be performed and the claim does **not** recite sufficient structure, material, or acts for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph. For more information, see MPEP § 2181.

Examiner notes that the one or more processors are a sufficient structure, material or act that modify the “means for” language.

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Per Claims 44-48 and 50-52, the scope of the system claim is not clear. In particular, it is not clear whether the auction manager is a software, hardware or a combination of both.

Appropriate correction is requested.

For examination purpose, Examiner treats the auction manager as a processor configured to execute instructions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19, 22, 24, 26-27, 30, 33, 35-36, 39, 41-42, 44-45, 48, 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (USPN 5845265) (“Woolston”) in view of Fraser et al (US 5329589) (“Fraser”) and further in view of Philips et al (USPN 5047959) (“Philips”).

Re claims 18, 26, 35 and 44: Woolston teaches computer system for conducting an auction through a computer network, the system comprising: a posting means for posting to a computerized merchandise catalog information that is accessible through the computer network, the information describing each lot in a plurality of lots available for auction, each lot including at least one item (col. 3, lines 8-67, col. 4, lines 10-27, col. 5, lines 48-55), the posting means available to add a lot for auction during an auction of another lot, wherein the information related

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to items in each lot is substantially continuously updated in the merchandise catalog as items in each lot are made available for auction (col. 7, lines 16-30); a bid receiving means for receiving a bid for at least a portion of a lot of the plurality of lots (col. 6, lines 21-29); a bid validation means for examining the bid (col. 6, lines 37-44); and a bid categorizing means for determining whether the bid is successful or unsuccessful (col. 6, lines 30-33, col. 10, lines 33-63), and a bid database for storing the bid (col. 6, lines 21-44), wherein the posting means, bid receiving means, bid validation means and bid database are implemented with one or more processors configured to execute instructions stored in memory (figure 1).

Woolston does not explicitly teach a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction and for ensuring that the bid amount is credible in view of a current high bid, the characteristic of the bid being a form of bid information, and the validating of the characteristic includes ensuring that the bid information accords with a specific form of the bid information that is defined by a bid format.

Fraser teaches a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction, the characteristic of the bid being a form of bid information (col. 14, lines 16-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to valid a characteristic of bid as taught by Fraser. One would have been motivated to do so in order to ensure that the bid information is valid.

Philips, using the same problem solving technique, teaches the concept of examining the characteristics of data entered by a user to validate the data for ensuring that the data values (bid amount) are credible in view of a valid data criterion (current high bid), and the validating of the

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characteristic includes ensuring that the data values accords with a specific form of the data value that is defined by a data type or set or range of legal values (bid format) (col. 6, lines 40-58, col. 7, lines 38-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston and Fraser combination to include this feature as taught by Philips. One would have been motivated to do so in order to insure that the values entered by the user are valid, thereby preserving the integrity of process/system.

Re claims 19, 27, 36 and 45: Woolston teaches an auction selection means for associating each lot of the plurality of lots with an auction format selected from a plurality of auction formats (col. 5, line 50)

Re claims 22, 30, 39 and 48: Woolston teaches wherein the posting means is adapted to receive a message posted through the computer network corresponding to a lot and to post the message in association with the descriptive information for that lot (Figure 13).

Re claims 24, 32, 33, 41, 42, 50 and 51: Woolston teaches wherein the bid receiving means is for receiving bids on at least two lots that are simultaneously open for auction, the at least two lots having different associated auction formats, and wherein the bid categorizing the means is for automatically categorizing the received bids as successful or unsuccessful in accordance with the associated auction format for each lot (col. 11, lines 6-10).

Claims 20, 28, 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Philips in view of Huberman (US 5826244) (“Huberman”).

Re claims 20, 28, 37 and 46: Woolston/Fraser/Philips combination does not explicitly teach an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction.

Huberman teaches an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction (col. 10, lines 48-61).). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Philips combination to include this feature as taught by Huberman. One would have been motivated to do so in order to allow for flexibility taking into account customer preferences and the nature and characteristics of the item being auctioned.

Claims 21, 29, 38 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Philips in view of Brown (US 5794219) (“Brown”).

Re claims 21, 29, 38 and 47: Woolston/Fraser/ Philips combination does not explicitly teach wherein bid-receiving means receives the bid from a bid form. Brown teaches wherein bid-

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receiving means receives the bid from a bid form (Figures 5, 6 and 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Philips combination to bid forms as taught by Brown. One would have been motivated to do so in order to provide a standard format for which bidder enter their bids.

Claims 25, 34, 43 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Philips in view of Mackinnon, D. J. ("Playing the Auction Game"; SU2 Edition, Toronto Star, Ont.: Oct. 4, 1987. pg E.1) ("Mackinnon").

Re claim 25, 34, 43 and 52: Woolston/Fraser/ Philips combination does not explicitly teach proxy bidding. Mackinnon teaches of proxy bidding (page 3 of 3, paragraph 26). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Anderson combination to include this feature as taught by Mackinnon. One would have been motivated to do so in order allow participant to set maximum bids without monitoring the auction.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 26-30, 32-39, 41-48 and 50-52 under 35 U.S.C. § 112, first paragraph.

1. Regarding claims 26, 35 and 44, Appellant asserts that the specification provides support for the limitation “a bid validation... for ensuring that the bid amount is credible in view of a current high bid” (see Appeal Brief, page 12-14). Specifically, Appellant asserts that the support can be found on page 12, lines 8-12, page 14, line 1 through page 15, line 7, page 16, lines 10-18 and figs. 2 and 3.

In Response: The Examiner respectfully disagrees. Examiner notes that bid validation with reference to the current high bid is not explicitly recited in the specification. Examiner asserts that bid validation can be done with reference to or in view of any parameter. For example, bid validation can be done in view of a predetermined specific amount such as reserve price or a minimum starting bid, and NOT necessarily in view of current high bid as alleged by the Appellant.

2. Regarding claims 44-48 and 50-52, Appellant argues that the auction manager is definite when considering the claim as a whole.

In Response: The Examiner respectfully disagrees. There is nothing in the originally filed specification that ties the auction manager to the specific function as recited in the claims. That is, querying the bid database to automatically determine whether the bid is successful or unsuccessful.

Rejection of claims 26, 35 and 44 under 35 U.S.C. § 103(a) as unpatentable over Woolston in view of Fraser and further in view of Philips.

1. Regarding claims 26, 35 and 44, Appellant asserts Woolston fails to teach “add a second lot to the plurality of lots during an auction of the first lot of the plurality of lots by posting on the computerized merchandise catalog information that is descriptive of items in the second lot, **wherein the information pertaining to the second lot is added to the merchandise catalog as at least a portion of the first lot of the plurality of lots is made available for auction** (see Appeal Brief, page 12-15). Specifically, Appellant asserts that Woolston fails to teach adding a second lot of items to a merchandise catalog during an auction of the first lot of item (see Appeal Brief, page 15).

In Response: The Examiner respectfully disagrees. As a preliminary matter, Examiner notes that the Appellant cited page 15, lines 15-21; page 16, line 20 through page 17, line 4; fig. 4, elements 25 and 26; fig. 6, elements 51, 52 and 53, as proving support for this limitation (see Appeal Brief, page 6). Upon review of these portions, Examiner asserts that the claim language is not commensurate in scope with the cited portion. Nothing in the specification adds second lot information to the merchandise catalog during an auction of a first lot. Examiner notes that cited portions only deals with opening new items for sale and closing auctions for old items and is interpreted as such. The new and old items are not functionally related in terms of when a second lot is added as recited in the claim language. Based on this interpretation, Examiner asserts that Woolston teaches this at col. 5, line 45 through col. 6, line 40; col. 11, lines 5-10.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Olabode Akintola /Olabode Akintola/
Art Unit 3691
05 November 2010

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